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REMARKS

In the Office Action, claims 1-17 and 19-21 were rejected. By the present Response, claims 1, 3-8, and 10-16 have been amended and new claims 22 and 23 have been added. Claims 1-17 and 19-23 are now pending in the present application. Reconsideration of the rejections and allowance of the pending claims are respectfully requested.

Rejections under 35 U.S.C. §102

In the Office Action, the Examiner rejected claims 1-17 and 19-21 under 35 U.S.C. §102(b) as being anticipated by Kimble, U.S. Patent No. 4,781,422. Claims 1 and 3-8 have been amended by this response. In the Office Action, the Examiner stated that:

Regarding claims 1, 2, and 8, Kimble disclosed (Fig. 1-3) a computer system (10), comprising:
a base (11); a display enclosure (14-16) housing a display (13); and a securing mechanism (17, 18) to pivotably secure the display enclosure (14-16) to the base (11), comprising:
a positioning assembly (29) that produces a frictional force to prevent the display enclosure (14) from pivoting; and a selectively and mechanically actuated operator (75, 85), the operator (75, 85) being adapted to selectively (i.e. when a user so desires) remove the force preventing the display enclosure (14-16) from pivoting. The functional recitation: "operator being adapted to...remove the force...without use of a tool (emphasis added)" has not been given patentable weight, because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279. In the instant case the sufficient structure has not been presented in support of the ability of the device to be adjusted without use of a tool.

Also, it has been held that the recitation that an element is "adapted to" perform a function is not a positive

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limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claims 1-9

Applicant respectfully traverses the rejection. Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984).

For the reasons provided below, claims 1-9 are not anticipated because the Kimble reference does not disclose all of the recited features of the claims. In addition, the rules of claim interpretation stated by the Examiner are incorrect. As a result, the Examiner has improperly interpreted the claims.

The rules of claim interpretation suggested by the Examiner are incorrect for several reasons. First, to be given patentable weight, a functional recitation does not have to be expressed as a "means" for performing the specified function. Second, a functional limitation does not have to "be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language."

There is no portion of 35 U.S.C. § 112, sixth paragraph, which requires that all functional limitations be expressed as a "means for performing." Furthermore, a functional limitation does not have to "be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language," as suggested by the Examiner. What 35 U.S.C. § 112, sixth paragraph, does state is that: "An element in

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a claim for a combination may be expressed as a means for performing a specified function without the recital of a structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (Emphasis added)." Thus, 35 U.S.C. § 112, sixth paragraph, expressly contradicts the Examiner's assertion that in addition to expressing the functional limitation as a "means for performing" the functional limitation "must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language." In addition, the *Fuller* case cited by the Examiner does not support the Examiner's assertion. The *Fuller* case predates the statute by several decades and says nothing about a functional limitation needing support in the claim of sufficient structure to warrant the presence of the functional language.

The Examiner is apparently misconstruing M.P.E.P. § 2181. M.P.E.P. § 2181 sets forth guidelines for the examination of 35 U.S.C. 112, sixth paragraph "means or step plus function" limitations in a claim. M.P.E.P. § 2181 states that:

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

(A) the claim limitations must use the phrase "means for " or "step for ";

(B) the "means for " or "step for " must be modified by functional language; and

(C) the phrase "means for " or "step for " must not be modified by sufficient structure, material or acts for achieving the specified function (emphasis added).

Thus, if the claim does not use the phrase "means for," the claim is not to be interpreted to invoke 35 U.S.C. 112, sixth paragraph. However, that does not mean that a

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functional limitation must invoke 35 U.S.C. 112, sixth paragraph. In addition, the guidelines contradict the Examiner's assertion because even if the claims recite "means for," M.P.E.P. § 2181 specifically states that: "the phrase "means for " or "step for " must not be modified by sufficient structure, material or acts for achieving the specified function" or the claims are not to be interpreted to invoke 35 U.S.C. 112, sixth paragraph. Thus, if the claim has sufficient structure, the claims cannot be interpreted to invoke 35 U.S.C. 112, sixth paragraph.

Furthermore, M.P.E.P. § 2173.05(g) specifically states that: "There is nothing inherently wrong with defining some part of an invention in functional terms." "A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." *See id.* In addition, M.P.E.P. § 2173.05(g) goes on to state that: "A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is recited by the element, ingredient or step." Therefore, a functional recitation does not have to be expressed as a "means" for performing the specified function or be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language.

Furthermore, the Examiner has misinterpreted the court's decision in the case of *In re Hutchison*. The court in *In re Hutchison* did not hold that an element "adapted to" perform a function is not a positive limitation or that "adapted to" does not constitute a limitation in any patentable sense, *per se*. The terms "adapted for" and "adapted to" were recited in the preambles of several claims, not in the bodies of the claims. *See In re Hutchison*, 154 F.2d 135, 137 (C.C.P.A. 1946). The Appellant had argued that these terms were a limitation that distinguished the claims from the prior art. *See Id.* The court rejected the Appellant's argument and in its decision the Court stated that the term "adapted to" did not constitute a limitation in any patentable sense. However, this

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statement was made in the context of the term being found in the preamble of the claim, not that the term "adapted to" was not a positive limitation, *per se*.

In fact, other courts have cited *In re Hutchison* for the proposition that terms found in the preamble of a claim are not limitations, not that the term "adapted to" is not a positive limitation. See *Kropa v. Robie*, 187 F.2d 150 (C.C.P.A. 1951) (See Appendix A. *Ex Parte* cases in which preamble held not to express limitation in claim. Case No. 19); See also *In re Allen*, 343 F.2d 482 (C.C.P.A. 1965). The Applicant found no case in which *In re Hutchison* was cited by another court for the proposition that the term "adapted to" does not recite a positive limitation or has no patentable sense, *per se*. Thus, *In re Hutchison* does not support the Examiner's assertion that "it has been held that the recitation that an element is 'adapted to' perform a function is not a positive limitation but only requires the ability to so perform" or that "It does not constitute a limitation in any patentable sense." Let it be noted that in the present claims, the term "adapted to" is recited in the bodies of the claims, not in the preambles.

Furthermore, M.P.E.P. § 2173.05(g) specifically cites an example where the term "adapted to" was found to precisely define present structural attributes of interrelated components. M.P.E.P. § 2173.05(g) states that:

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions...being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly (emphasis added). *In re Venezia*, 530 F.2d 956, 189 U.S.P.Q. 149 (CCPA 1976).

For all of these reasons, there is no support in the cited case or in the M.P.E.P. for the Examiner's assertion that "it has been held that the recitation that an element is

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'adapted to' perform a function is not a positive limitation but only requires the ability to so perform. Therefore, for the reasons provided above, the Examiner must consider the claim limitations disclosed therein.

Using the proper rules of claim interpretation, claims 1-17 and 19-24 are not anticipated by the cited reference. One of the recited features of amended independent claim 1 that is not disclosed by the Kimble reference is:

a switch coupled to the positioning assembly, the switch having a first state which causes the positioning assembly to be in the first position and a second state which causes the positioning assembly to be in the second position.

The Kimble reference discloses a bolt 75 that is screwed into a tapped opening 81 of a plate 82, not a switch. *See Kimble*, col. 4, lines 3-4. Tightening the bolt 75 causes the bolt head 85 of bolt 75 and plate 82 to move toward each other. *See Kimble*, col. 4, lines 11-13. Continued tightening of bolt 75 forces plates 34 and 54 against each other to create friction and thereby oppose the rotational movement of plates 34 relative to plates 54. *See Kimble*, col. 4, lines 14-23. Bolt head 85 has a slot to enable the bolt 75 to be turned by a screwdriver. *See Kimble*, Fig. 2. The Kimble reference does not disclose a switch. In addition, the Kimble reference does not disclose a switch that has a first state which causes bolt 75 or plate 82, or any other component, to be in a first position and a second state which causes bolt 75 or plate 82, or any other component, to be in the second position. Therefore, the Kimble reference does not disclose all of the recited features of amended independent claim 1. Accordingly, Kimble does not anticipate claim 1.

In addition, for the reasons provided above, the Kimble reference does not anticipate claims 2-9, which depend from claim 1. In addition, the Kimble reference does not disclose all of the recited features of the claims. For example, the Kimble reference does not disclose: "wherein the switch is an electrical switch," as recited in claim 7. As

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discussed above, the bolt 75 must be tightened by a screwdriver or similar tool, it is not electrically actuated. Withdrawal of the rejection and allowance of the claims are respectfully requested.

Claims 10-16

Claims 10-16 also are not anticipated by the Kimble reference. In the Office Action, the Examiner stated that:

Regarding claims 10 and 14, Kimble disclosed (Fig. 1-3) a clutch assembly (29) for pivotably securing a computer display (14-16) to a computer base (11), comprising:

a first portion (16, 54, 55) to enable the computer display (14) to pivot relative to the computer base unit (11); a second portion (34, 36) to produce a force to oppose pivotal motion of the display (14); and a manually and mechanically actuatable third portion (75) operable to prevent the second portion (34, 36) from opposing pivotal motion of the display (14).

Claim 10 is not anticipated because the Kimble reference does not disclose all of the recited features of the claim. One of the recited features of amended independent claim 10 that is not disclosed by the Kimble reference is: "clutch operator selectively switchable to produce a counter-force to the force produced by the friction clutch to prevent the friction clutch from opposing pivotal motion of the display." The bolt 75 does not produce "a counter-force to oppose the force...opposing pivotal motion of the display." Furthermore, the Examiner did not even address this recitation in the rejection. Therefore, the Examiner has failed to provide a *prima facie* argument that the Kimble reference anticipates claim 10. Furthermore, the bolt 75 is not "switchable." The bolt 75 produces the force to oppose pivotal motion of the display 13. The bolt 75 is not "switchable" to provide a counter-force to prevent the friction clutch from opposing pivotal motion of the display 13. For all of these reasons, the Kimble reference does not disclose all of the recited features of claim 10. Accordingly, claim 10 is not anticipated by the Kimble reference.

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Furthermore, claims 11-16 are not anticipated by the Kimble reference. Claims 11-16 depend from independent claim 10 are not anticipated by virtue of their dependence from claim 10. In addition, claims 11-16 are patentable by virtue of their own recited subject matter. For example, the Kimble reference does not disclose "wherein the clutch operator is electrically operated," as recited in claim 11 or "a manually operable switch operable to control electrical power to the clutch operator," as recited in claim 12. Therefore, withdrawal of the rejection of claims 10-16 is respectfully requested.

Claims 17 and 19-21

Claims 17 and 19-21 are not anticipated because the Kimble reference does not disclose all of the recited features of the claims. Some of the recited features of amended independent claim 17 that are not disclosed by the Kimble reference are: "actuating a clutch assembly before the display is pivoted to reduce a force opposing pivotal motion of the display" and "deactuating the clutch assembly after the display is pivoted to restore the force opposing pivotal motion of the display."

In the Office Action, the Examiner stated that: "Regarding claims 17 and 19-21, the method steps recited in the claims are inherently necessitated by the device structure as disclosed by Kimble." However, the Kimble reference does not support the Examiner's assertion. The display 13 of Kimble can be pivoted without loosening and tightening the bolt 75. Therefore, there is nothing inherent to the structure of the Kimble reference to necessitate "actuating a clutch assembly *before the display is pivoted* to reduce a force opposing pivotal motion of the display." Consequently, there is nothing inherent in the bolt 75 of Kimble to tighten the bolt 75 *after the display 13 is pivoted* to restore the force opposing pivotal motion of the display. Therefore, the Kimble reference does not disclose all of the recited features of independent claim 17. Thus, the Kimble reference does not anticipate claim 17, or claims 19-21, which depend therefrom. Withdrawal of the rejection and allowance of the claims are respectfully requested.

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New Claims

New claims 22 and 23 have been added by this Response. New claims 22 and 23 add no new matter and are fully supported throughout the specification. Furthermore, Applicant authorizes the Commissioner to charge the appropriate fee of \$120.00 for the additional claims to Deposit Account No. 08-2025; Order No. COMP:0210/FLE (200301920-1).

Conclusion

In view of the above remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: August 22, 2003



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AUG 25 2003

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